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NEW YORK NY 10019

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MAR 08 2010

In re Application of :
Igakura :
Application No. 09/960,548 : DECISION
Filed: 20 September, 2001 :
Attorney Docket No. P/1866-65 :
:

This is a decision on the petitions, filed on 22 December, 2009, and considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 C.F.R. §1.181 is **DISMISSED**.

Any request for reconsideration of this decision should be filed **within two (2) months** from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a “Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment.”

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

**As to the Request to Withdraw
the Holding of Abandonment**

Petitioner is directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

Petitioner appears **not** to comply with the guidance in the Commentary at MPEP §711.03(c)(I)—as discussed below, Petitioner has failed to satisfy the showing requirements set forth there. **Petitioner may find it beneficial to review that material and move step-wise through that guidance in the effort to satisfy the showing requirements** (statements and supporting documentation).

BACKGROUND

The record reflects as follows:

The history of this matter is long-troubled and marked by Petitioners now-repeated failure to comply with, *inter alia*, the guidance in the Commentary at MPEP §711.03(c)

Previously:

Petitioner failed to reply timely and properly Notice of Noncompliant Appeal Brief mailed on 21 December, 2006, with reply due absent extension of time on or before Monday, 22 January, 2007. The application went abandoned by operation of law after midnight 22 January, 2007. The Office mailed the Notice of Abandonment on 31 July, 2007. On 13 June, 2008, Petitioner filed a petition, asserting, *inter alia*, that the Notice of Noncompliant Appeal Brief was not received, a search of the file and non-discovery, and provides statements by Petitioner and Ms. Henrietta Marron, who is averred to docket materials received in the mail from the Office, and a due-date docket calendar for 21 January, 2007. However, in view of the fact that the due date was a non-business day (a Sunday) and the next day was the last date for reply—and thus the reply due-date—there was no showing as to the calendar for that date and it does not appear that Petitioner included a copy of the docket sheet/file jacket cover for the instant application. Moreover, the Office mailed the Notice of Abandonment on 31 July, 2007, and under the rule (37 C.F.R. §1.181), Petitioner had two (2) months to seek relief from the act complained of, which timeliness requirement Petitioner failed to satisfy with the instant petition filed nearly eleven (11) months after the Notice of Abandonment. The petition was dismissed on 5 September, 2008. On 22 September, 2008, Petitioner filed a petition pursuant to 37 C.F.R. §1.137(b), which was granted on 28 November, 2008.

Thereafter:

On 6 March, 2009, the Office re-mailed the Notice of Non-Compliant Amendment. Petitioner filed an Amended Brief on 6 April, 2009.

On 8 April, 2009, the Examiner mailed an Interview Summary noting therein that “applicant will clarify the mapping of the limitations in an amended appeal brief.” (Emphasis supplied.)

On 8 May, 2009, Petitioner submitted a post-summary “Statement of Substance . . .,” however, Petitioner clearly failed to reply timely and properly to the Interview Summary, as set forth above, in the form of an Amended Appeal Brief to “clarify the mapping of the limitations.”

Petitioner’s apparent determination to do things his way and not to comply with the requirements as expressly set out in writing by the Examiner on 8 April, 2009, did not constitute a timely and proper reply, and Petitioner’s attempt to “spin” the facts did not and will not substitute for compliance.

Petitioner can either comply with the requirements as set forth in the guidance in the Commentary at MPEP 711.03(c)(I), or he can filed a petition (with fee) to revive pursuant to to 37 C.F.R. §1.137(b)—and his failure to take that action promptly may be considered as *indicia* of delay that is not unintentional.

The guidance in the Commentary at MPEP §711.03(c)(I) provides in pertinent part:

* * *

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. 1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the

private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512.¹

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears not to have made the showing required.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.181 is dismissed.

¹ *See*: MPEP §711.03(c) (I)(B).

² *See* supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. *See Changes to Patent Practice and Procedure*, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See:
http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” (The statement is in the form available online.)

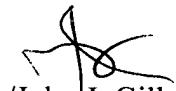
Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By facsimile: **(571) 273-8300**
 Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.